

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Art Unit : 1745
Examiner :
Serial No. : 10 045,848
Filed : November 7, 2001
Inventors : Hiroki Nakamaru
: Tomoshige Ono
: Yoshiei Kato
Title : IRON POWDER FOR
: REMEDIATION AND
: METHOD FOR REMEDIATING
: SOIL, WATER, OR GAS



22469

Docket No.: 1315-01

Confirmation No.: 2392

Dated: August 21, 2002

REQUEST FOR RECONSIDERATION

Box DAC

Commissioner for Patents
Washington, DC 20231

Sir:

This is submitted in response to the Decision on Petition dated July 17, 2002. Reconsideration is respectfully requested for the reasons set forth in detail below.

* * *

The facts in this case are simple: On November 7, 2001, the Applicants filed a complete patent application which included all of the 20 pages of the Specification, two pages of Claims, an Abstract, an Oath or Declaration, an Assignment and a Recordation Cover Sheet, an Application Transmittal Letter, an Express Mail Certificate, a check for the complete Application fee, a check for the Assignment recordal fee and a postcard. The Patent Office apparently has no record of receipt of pages 2, 3, 13, 17 and 19 of the Application. The Applicants have submitted corroborating evidence that the missing pages were, in fact, filed. The Applicants were also fully in compliance with the MPFP.

Accordingly, pages 2, 3, 13, 17 and 19 were, in fact, filed on November 7, 2001 and should be entered as part of the original disclosure.

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OFFICE OF PETITIONS

Applicants note with appreciation the Petitions Attorney's helpful references to portions of the MPEP, especially §503.

The Applicants have no dispute whatsoever concerning the above-identified sections of the MPEP and, in fact, note an additional portion of MPEP §503 which was omitted from the portions of the MPEP cited in the text spanning pages 1 and 2 of the Decision on Petition. That omitted portion is recited below for the sake of convenience:

If a receipt of any item (e.g., paper or fee) filed in the USPTO is desired, it may be obtained by enclosing with the paper a self-addressed postcard specifically identifying the item. The USPTO will stamp the receipt date on the postcard and place it in the outgoing mail. A postcard receipt which itemizes and properly identifies the items which are being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO.

It is important to recognize that this portion specifically states that a postcard receipt which itemizes and properly identifies the items which are being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO.

In this case, the Applicants' return postcard clearly "itemized" the enclosures. Those materials were itemized as follows: \$740.00 check, \$40.00 check, Express Mail Certificate, Application Transmittal Letter, in duplicate, Specification, including Claims and Abstract, executed Combined Declaration, Power of Attorney and Petition, Recordation Form Cover Sheet - Patents Only and executed Assignment. Thus, not only was the existence of a "patent application" identified but, in this case, all three relevant portions, namely the Specification, Claims and Abstract, were specifically and particularly "itemized" in accordance with the MPEP. Thus, there can be no doubt whatsoever that the postcard "itemized" each and every separate "item" or component of the Application and the other enclosed documents.

The final paragraph of MPEP §503 identified on page 2 of the Decision states that the postcard receipt will not serve as *prima facie* evidence of receipt of any item which is

not adequately itemized on the postcard. In this case, every "item" or component of the complete Application was specifically and individually itemized. Therefore, since the postcard did, in fact, itemize every item, the postcard serves as *prima facie* evidence of receipt of all of those items.

The non-emphasized portion of that paragraph provides an illustration of what is not itemization, but serves only as a mere "listing". Such a mere listing includes a "complete application" or "patent application". That same sentence which identifies the mere listing identifies the so-called "required components of an application", which include as examples Specification, including Claims, Drawings, Oath or Declaration and the Application filing fees. The Applicants' postcard specifically listed a Specification, Claims and Abstract, an Oath, an Assignment, a Transmittal Letter, an Express Mail Certificate and two checks. This is exactly the itemization sought by and specified in MPEP §503. That is the point where the analysis concludes because the Applicants' postcard did itemize every component and is, therefore, by definition *prima facie* evidence of receipt of the entire Application.

The paragraph preceding the final paragraph on page 2 of the Decision is a type of paragraph which provides for an "ideal" identification of such papers. However, that paragraph contains critical differences from the other paragraphs of MPEP §503. The other paragraphs state explicitly that a postcard receipt "which itemizes... serves as *prima facie* evidence". Also, the other paragraphs state that the "postcard receipt will not serve as *prima facie* evidence of receipt of any item which is not adequately itemized on the postcard." These are so-called "mandatory" paragraphs as to the minimum that is required.

In sharp contrast, the excerpt from the MPEP on the second to the last paragraph on page 2 of the Decision is not a so-called "mandatory" paragraph, but more of an "aspirational" paragraph. This is evidenced by the fact that it states, for example, that the identifying data on the postcard "should be so complete...". That paragraph also says that "the postcard should also identify the type of paper being filed...". It further states that,

if a new application is being filed, all parts of the application submitted "should be" separately listed. Accordingly, we respectfully submit that this paragraph of the MPEP does not require that the number of pages of the Specification be set forth on the postcard. It does not require the number of claims be set forth and it does not require the number of sheets of drawings or the number of pages of the Oath or the number of pages of the cover sheet. All of this language is couched in the form of "should be". This is in sharp contrast to the other paragraphs of the MPEP that state that, essentially, the components "shall be" itemized. In this case, the Applicants properly identified, in an item-by-item manner, all of the components of the patent application strictly in accordance with the required portions of MPEP §503. Nothing more is required. It is not required that the number of pages be set forth, inasmuch as MPEP §503 merely states that such identifying data "should be" present. There is a critical difference between "must be" and "should be".

We accordingly respectfully submit that, on this basis alone, the Applicants complied with the rules and that the apparently missing pages should be entered into the Specification as originally filed and accorded the proper filing date of November 7, 2001.

* * *

In any event, the Applicants have submitted corroborating evidence as to the fact that the papers were properly filed. The first item of evidence is the postcard which is fully in compliance with MPEP §503 as described above. The second piece of evidence, which by definition corroborates the first piece of evidence, is the Declaration of the undersigned. That Declaration, signed by an experienced practitioner before this Office for well over 15 years, having filed hundreds of patent applications, was executed under the penalties set forth under §1001 of Title 18 of the United States Code. The undersigned does not make such statements lightly and surely does not make them if they are not true. The facts, as set forth in the Declaration, are that the undersigned counted every page in the Application, that the missing pages 2, 3, 13, 17 and 19 were, in fact, present and placed in the Express Mail envelope as set forth in the Declaration. Any conclusion made

to the contrary is simply a total dismissal of the veracity and honesty of an experienced practitioner before the Office and the Applicants respectfully submit that this is simply unfounded.

A further item of corroborating evidence was submitted in the form of a second Declaration of Ms. Ginola Johnson. This Declaration was also submitted under §1001 of Title 18 of the U.S. Code. The two Declarations corroborate each other and further corroborate the properly submitted postcard in accordance with MPEP §503. The existence of the postcard and these two Declarations alone establish, far beyond a preponderance of evidence, that the Applicants, in fact, submitted pages 2, 3, 13, 17 and 19 of the Specification on November 7, 2001.

Upon further investigation, the Applicants have a still further piece of corroborating evidence. This third piece of corroborating evidence is in the form of a Declaration of still a third person who checked the Application in its entirety and it was found that all of the pages, including pages 2, 3, 13, 17 and 19 of the Specification, were, in fact, present. We accordingly submit herewith a Declaration of Ms. Regina Belitz so stating.

* * *

The Applicants have now submitted four separate pieces of evidence, each establishing that the complete Application, including pages 2, 3, 13, 17 and 19 of the Specification, was present at the time of filing on November 7, 2001. By definition, the mere presence of two pieces of evidence corroborate one another. This is one of the oldest concepts in the law as set forth in Black's Law Dictionary (Fifth Edition) as follows:

To strengthen; to add weight or credibility to a thing by additional and confirming facts or evidence. The testimony of a witness is said to be corroborated when it is shown to correspond with the representation of some other witnesses, or to comport with some facts otherwise known or established.

Two pieces of evidence are, accordingly, corroborating.

There are now four pieces of evidence on the record corroborating the fact of filing of the complete Specification, including pages 2, 3, 13, 17 and 19, on November 7, 2001.

The Applicants respectfully submit that those pages were, in fact, present and should be accorded the original filing date of November 7, 2001.

We note with appreciation that the Decision on Petition refers to the Federal Register and the Official Gazette in a footnote and recites a case decision from the District Court in the District of Columbia. The facts in those cases are completely different and involve utilization of "Express Mail", which is not at issue in this case. Moreover, this case includes three Declarations and a postcard which *prima facie* establishes the presence of the items in accordance with MPEP §503. The Applicants, therefore, respectfully submit that references to such decisions are inapposite.

Finally, we note with appreciation the comments in the Decision with respect to the file wrapper, which is an official government record prepared and maintained by disinterested USPTO employees as part of their customary and usual duties. The postcard in this case bears indicia that it was subjected to an ultraviolet irradiation procedure by virtue of its discoloration and brittleness (including two corners broken away). This procedure coincides with the post September 11, 2001 anthrax scare and the November 7, 2001 filing date of this Application. This fact raises serious questions as to whether this Application, or parts thereof, was, in fact, in the possession of the USPTO at all relevant times. The apparent exposure to UV irradiation indicates that the Application was very likely not in the custody of USPTO employees at all times and may, in fact, have been in the possession of others, maybe not even employees of the United States Government, at some point in time.

Further, for such a UV irradiation process to be effective, each sheet of paper would require UV exposure, at which point the integrity of every sheet of the application could be compromised. In other words, it would be easy for pages of a document to be misplaced during such a procedure.


Thus, the Applicants question the integrity of the chain of possession of this Application prior to or after its receipt at the USPTO through its processing in the usual USPTO channels. Thus, we respectfully submit that it is not only possible, but highly

likely that the UV irradiation process which this Application was apparently subjected to may have resulted in the loss of the pages at issue in this Application in an environment not involving USPTO employees who would normally be highly sensitive to the presence of each and every page of a patent application.

* * *

In light of the foregoing, we respectfully submit that the Applicants have established, beyond a preponderance of doubt, that the Applicants properly and timely submitted pages 2, 3, 13, 17 and 19 of the Application with the USPTO on November 7, 2001 and that there was ample opportunity for misplacement of those pages for reasons totally beyond the control of the Applicants. We accordingly respectfully request reconsideration of the Decision on Petition, entry of those pages into the original Application and that they be accorded the original filing date of November 7, 2001.

Respectfully requested,


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